

**REMARKS**

Claims 1-7, 21, 25 and 34-61 are pending in this application. Claims 36-37, 46-47, 57-58 are cancelled without prejudice or disclaimer and claims 1, 3, 21, 25, 41, 51 and 59-60 are amended, herein.

Claims 1-7, 21, 25 and 34-61 stand rejected under the judicially created doctrine of double patenting over claims 1, 29, 34, and 36-97 of co-pending application serial number 09/250,675. The rejection is respectfully traversed.

It is respectfully submitted that the claims currently pending in the '675 application are clearly distinguishable from the present claims. More particularly, with regard to the '675 application, each of the independent claims of the present application requires directing the payment of a plurality of bills on behalf of a plurality of consumers by a single consolidated payment. Each of the claims of the '675 application require directing that payment be made either using a first form of payment or a second form of payment. Hence, the claims of the present application and those of the '675 application are clearly distinguishable and are directed to different inventions.

Accordingly, it is respectfully requested that the double patenting rejection relating to the '675 application be reconsidered and withdrawn.

Claims 1-7, 21, 25 and 34-58 stand rejected under 35 USC §112, first paragraph, as unsupported by the specification. The rejection is respectfully traversed.

The Examiner contends that there is no support in the specification for the claim recitals relating to ATM/POS networks and nodes on such networks.

Contrary to the Examiner's contention, the Lawlor reference, which has been applied by the Examiner, clearly evidences that ATM/POS networks were well known by those skilled in the art prior to December 1989. Lawlor's background statement is replete with references to ATM and ATM/POS networks.

The Examiner notes that the term "nodes" is defined in various ways. However, each of the referenced definitions indicates that a network "node" is a junction or point on the network with which it is associated. Hence, it is respectfully submitted that the meaning of the recited "node on an ATM/POS network" is, and would have been at the time of filing the present application, well understood by those skilled in the art.

As to the specification's lack of explicit reference to ATM/POS networks, no such disclosure was necessary, since the present invention avoids the use of ATM/POS networks in accomplishing its stated objective. Further still, those skilled in the art would clearly recognize that the invention, as disclosed in the present application, does not require processing at a node on an ATM/POS network, since debits from the consumers accounts are disclosed to be accomplished by an ACH transfer (i.e. via the ACH network) and not by an ATM transfer (i.e. via the ATM network).

One reason for this is that one of the objectives of the present application is to provide a universal payment system wherein anyone can pay anyone. As is recognized in the art, ATM networks to this day only allow debiting from accounts of those banks which subscribe to the particular ATM network being utilized. Hence, in order for Lawlor to provide universal bill payment, it would be necessary to

either require that all financial institutes maintaining consumer deposit accounts subscribe to a single ATM network or that respective bill requests be processed at respective nodes on different ATM networks in order to fulfill payment requests.

The present system on the other hand, provides the capability for anyone to pay anyone irrespective of which ATM network or networks their financial institute subscribes to. Lawlor attempts to accomplish a substantially similar objective in a substantially different way than that of the present invention.

However, to avoid unnecessarily delaying the allowance of this application, claims 1, 21 and 25 are amended herein to delete, without prejudice or disclaimer, the language which the Examiner has noted to be of concern.

More particularly, independent claims 1, 21 and 25 are amended to incorporate features previously recited in the claims 36-37, 46-47, 57-58 (which are accordingly cancelled) to positively recite that the debiting of the payment amount from the consumers deposit account is accomplished by an ACH transfer, and hence outside of the ATM/POS network. Other dependencies of claims 1, 21 and 25 are amended in view of the amendments to their parent claims and to delete unnecessary limitations.

It is noted that in the Examiner's arguments relating to the prior art rejections of claims 59-61, the Examiner acknowledges Lawlor's failure to disclose debiting a consumer's account via an ACH network. However, the Examiner argues that since the ACH network is well known, it would have been obvious to those of ordinary skill in the art to modify Lawlor to debit consumer accounts via an ACH transfer.

However, according to Lawlor home banking systems using PC's operating special purpose software (i.e. outside of the ATM network) have been unsuccessful for various reasons (see column 1, line 20, through column 2, line 68). Lawlor also discloses that it has been proposed to provide bill paying services using the ATM and ATM/POS networks (see column 5, lines 8-19). Lawlor goes on to disclose that a practical architecture for providing comprehensive banking services, including paying bills to user selected payees, from ones home or office over standard telephone lines has yet to be proposed (see column 6, lines 31-36). Lawlor proposes to solve this problem by a new use of the existing ATM networks to provide transactions not previously supported by such networks, e.g. home initiated bill payment transactions (see column 7, lines 37-48). Hence, it is an express objective Lawlor to use the existing ATM/POS networks to effectuate bill payment from ones home or office.

According to Lawlor, consumer directed financial transactions are executed by a central computer in direct communication with the consumer's bank via an ATM/POS network (see column 11, lines 25-31). The central computer accesses and debits the consumer's account for the amount of a bill-pay request via the ATM/POS network. This accessing and debiting is done in real-time (see column 22, lines 32-37 and column 49, lines 18-46). This is the same accessing and debiting performed by any conventional ATM/POS network. As Lawlor expressly discloses, from a consumer bank's perspective, the central computer looks and behaves like any node on an ATM/POS network (see column 18, lines 35-38, column 33, lines 23-55, and column 42, lines 18-23). Thus, what Lawlor teaches is that customer directed

bill payment should be effectuated via existing ATM/POS networks to avoid the problems with previously proposed systems which had attempted to effectuate such payments outside of existing ATM/POS networks.

Accordingly, Lawlor is directed to utilizing ATM/POS networks to perform electronic bill payments. A primary feature of ATM/POS networks, as is well known in the art, is their use in debiting funds in an account maintained by a financial institute subscribing to the ATM/POS network. Accordingly, Lawlor, in keeping with its objectives, discloses that funds from the consumer's account should be debited exclusively via the applicable ATM/POS network. Notwithstanding the fact that Lawlor was clearly aware of the ACH network, which (as noted by the Examiner) Lawlor utilizes in transferring payments to payees, Lawlor does not suggest that ACH transfers could be utilized to debit the payor's account. Rather, Lawlor clearly failed to comprehend the advantages of utilizing ACH transfer instead of ATM transfers to debit a payor's account (not the least of these advantages being the practical ability to make payments from anyone to anyone). |||

Thus, if anything, Lawlor teaches against the use of other than an ATM network for debiting the payor's account, and lacks any suggestion or motivation of substituting ACH debits for the disclosed ATM debits. In fact, using ACH debits would be inconsistent with Lawlor's objectives of capitalizing on the widespread familiarity with the ATM network and avoiding training etc., which Lawlor viewed as otherwise necessary if ATM networks were not utilized (see column 6, lines 45-55). |||

The difference between the two types of systems is perhaps made most obvious by the fact that one can, today,

simply access the Internet home pages of Yahoo, the U.S. Postal Service, and numerous banks etc. to click-on a pay bill icon and pay bills (utilizing CheckFree's services) by having ones deposit account at a financial institute debited using an ACH transfer. Whereas, there would appear to be few, if any, commercially operating pay bill services in which bills are paid by having ones deposit account at a financial institute debited using an ATM transfer, as taught by Lawlor.

Accordingly, it is respectfully submitted that, as now recited in each of independent claims 1, 21 and 25, the processing of the received instruction to generate a debit instruction to direct the debiting of funds from a consumer's account by an ACH transfer, patentably distinguishes these claims and their dependencies over the applied Lawlor reference.

Other features recited in the dependencies of claims 1, 21 and 25 further and independently distinguish over the applied art. Such features include, but are not necessarily limited to: the transferring of funds from deposit accounts to the second deposit account by draft or credit card charge as recited in claims 6-7, 42-43 and 52-53.

Claims 59-61 stand rejected under 35 USC §112, second paragraph, as indefinite. Claims 59-60 are amended to address the Examiner's noted concer.

Claims 59-60 stand rejected under 35 USC § 102(e) as being anticipated by and claim 61 stands rejected under 35 USC §103(a) as obvious over Lawlor et al. (U.S. Patent No. 5,220,501). Claims 59 and 60 are amended to incorporate limitations previously recited in other pending claims to further distinguish over the applied art.

As understood, the Examiner bases the rejection on Lawlor's disclosure in the abstract, Figures 12 and 14a-14d, column 19, lines 9-11, column 23, lines 34-38, column 31, lines 50-58, column 33, line 3 through column 34, line 4, and column 49, lines 34-40. The Examiner points to column 19, lines 9-11, column 23, lines 34-38 and column 49, lines 7-28, of Lawlor as disclosing the debiting of consumer accounts in order to pay the bills. As discussed therein and in column 22, lines 32-37, and column 49, lines 18-46, Lawlor teaches ATM debiting of the consumer's account.

As amended, claims 59 and 60 now recite the debiting of the consumer's account either by a draft or a charge to a credit card. It is respectfully submitted that Lawlor lacks any suggestion of debiting the consumer's account by draft or charge to a credit card. Accordingly, it is respectfully submitted that claims 59 and 60 patentably distinguish over the applied art reference.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to

Deposit Account 12-0427 and please credit any excess fees to such deposit account.

Respectfully submitted,  
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